

REMARKS/ARGUMENTS**I. The Office Action**

In the above-mentioned non-final Office Action, claims 185-197 were rejected as failing to comply with the written description requirement; claims 134, 137-139, 142-147, 162, 164-165, 168-174, 176-177, 180-185, 188-189, 192-198, 200-202, 205-212, 214-215 and 218-223 were rejected as being anticipated by U.S. Patent 4,454,180 (*La Mers*); and claims 135-136, 140-141, 148-161, 163, 166-167, 175, 178-179, 186-187, 190-191, 199, 203-204, 213 and 216-217 were rejected as being unpatentable over *La Mers*.

In response to the Office Action, claims 134, 136, 158-159, 174, 183, 185, 198 and 212 have been amended, claims 135, 137-138, 141-142, 147, 154-155, 162-173, 179-181, 191-192, 194, 204-206 and 217-219 have been cancelled without prejudice or disclaimer and new claims 224-244 have been added.

II. All Claim Phrases Are Positive Limitations to be Given Patentable Weight

At the bottom of page 5 of the Office Action, the Examiner stated that the phrases "capable of" and "being configurable" were not "positive limitations" and hence, the Examiner did not give them any "patentable weight." In other words, he accorded those features no patentable weight; and he did not contend that those features presented 112, 102 or 103 issues, he simply ignored them. Further, the Examiner did not cite or refer to any section of the MPEP or to any case law for this claim construction technique.

Applicants respectfully contend that this claim construction "technique" by the Examiner is improper and that there is no support in the law for such technique. Accordingly, all of the features/phrases/terms in the bodies of all of the claims are positive limitations and must be accorded patentable weight in the examination of the claims.

The closest case which Counsel could locate in support for the Examiner's claim construction technique is *In re Hutchinson*, 154 F.2d 135 (CCPA 1946), and it is clearly not on point. In that case, the claim language was for a laminated article adapted for

use in making a template or the like. It is first noted that the *Hutchinson* claim language is in the preamble of the claim, while the claim language at issue in the subject application is in the body of the claim.

Second, the *Hutchinson* claim language states potential uses for the claimed material. In contrast, the claim language at issue in the subject application describes properties of the material. For example, the claim language at issue here is not: "A sheet of labels adapted for use in garage sales, comprising ... " where according to *Hutchinson* the language "adapted for use in garage sales" would not constitute a limitation in any patentable sense.

Third, a discussion of the state of the law beyond the 1946 CCPA *Hutchinson* decision follows. It will be readily apparent therefrom that the Examiner's claim construction technique is improper.

Again, the claim language at issue in the present application is not in the preamble, but rather in the body of the claim. However, even if it were in the preamble, there is no *per se* rule that it is not accorded patentable weight. Rather it is "a matter to be determined on the facts of each case in view of the claimed invention as a whole." *In re Stencel*, 828 F.2d 751, 754 (Fed. Cir. 1987).

For example, the preambular phrase "an abrasive article" was held to introduce a material limitation in *Kropa v Robie et al.*, 187 F.2d 150 (CCPA 1951).

The composition of matter claim at issue *In re Swinehart et al.*, 439 F.2d 210 (CCPA 1971) included in its body (not in its preamble) the phrase "transparent to infrared rays." The Examiner and the Board held in rejecting the claim that the claim was improperly functional. In its decision reversing the Board, the Court of Customs and Patent Appeals said:

We are convinced that there is no support, either in the actual holdings of prior cases or in the statute, for the proposition, put forward here, that 'functional' language, in and of itself, renders a claim improper. We have also found no prior decision of this or any other court which may be said to hold that there is some other ground for objecting to a claim on the basis of any language, 'functional' or otherwise, beyond what is already sanctioned by the provisions of 35 U.S.C. § 112.

In re Swinehart et al., *supra* at 213.

In re Venezia, 530 F.2d 956, 959 (CCPA 1976) in interpreting the claim language "each sleeve of said pair adapted to be fitted over the insulating jacket of one of said cables" said, "[r]ather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is so structured or dimensional that it can be fitted over the insulating jacket of a cable. A similar situation exists with respect to this 'adapted to be affixed' and 'adapted to be positioned' limitations in the third and fourth paragraphs of the claim." This case is cited in MPEP 2173.05(g) as is the above-discussed *Swinehart* case.

This section of the MPEP reads, in part, as follows:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure of specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971) ...

It was held that the limitation used to define a radical on a chemical compound as "incapable of forming a dye with said oxidizing developing agent" although functional, was perfectly acceptable because it set definite boundaries of the patent protection sought. *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971).

In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitation such as "members adapted to be positioned" and "portions ... being resiliently dilatable whereby said housing may be slidably positioned" served to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

The following are examples of recent opinions of the Board of Patent Appeals and Interferences on this point. It is noted that each of these opinions is not written for publication and is not binding precedent of the Board. They are very instructive, however, as to how the Board interprets claim language very similar to that at issue here. It will be seen that the Board does not employ the "technique" used by the Examiner herein, but rather considers all similar claim language as introducing positive limitations that are accorded patentable weight.

(1) *Ex parte Calhoun et al.*, Appeal No. 2003-1599, Paper No. 17. Claim language "sized and configured" was held to be a positive structural limitation.

(2) *Ex parte Miller et al.*, Appeal No. 97 -0972, Paper No. 13, pages 6-7. "The various functional limitations in the claims (e.g., that the elongated member is 'adapted to extend between an armrest assembly and a set member' set forth a function which the apparatus must be structurally *capable* of performing (see, e.g., *In re Venezia*, 530 F.2d 956, 959, 189 USPQ 149, 151-52 (CCPA 1976)) and such a functional statement must be given full weight and may not be disregarded in evaluating the patentability of the claims (see, e.g., *Ex parte Bylund*), 217 USPQ 492, 498 (Bd. App. 1981))." That is, the Board said that such functional statements must be given full weight and may not be disregarded in evaluating the patentability of the claim.

(3) *Ex parte Prall*, Appeal No. 2003-1556, Paper No. 24. The phrase "the removable spacer layer ... is adapted to be completely removed when isotropically etched" was held to impose a "capability requirement of part of the claimed semiconductor structure." (Emphasis added) It was therefore given patentable weight, by the Board, contrary to the Examiner's reliance on *In re Hutchinson, supra*.

(4) *Ex parte Brick*, Appeal No. 2000-1794, Paper No. 29, page 5. In reversing the Examiner's rejections of claims 1-11 and 13, the Board referring to *In re Swinehart, supra*, said that there is "nothing intrinsically wrong with the use of this ["adapted to be"] technique in drafting a patent claim." This was contrary to the Examiner's arguments that "the recitation that an element is 'adapted to' perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re [Hutchison]*, 69 USPQ 138."

(5) *Ex parte Belisle et al.*, Appeal No. 2002-2224, Paper No. 33. Claim language "such that the washer is removable from the shaft without breaking the washer or the shaft" was held to be a positive limitation in a patentable sense.

(6) *Ex parte Ligler et al.*, Appeal No. 1999-1384, Paper No. 15. Claim language that "the membrane may be rinsed and said device may be reused" was found to further limit the claimed device so that it is to reusable.

(7) *Ex parte Beckage*, Appeal No. 2003-0242, Paper No. 13. The examiner, citing *In re Hutchinson, supra*, contended that terminology that an element is "adapted to" perform a function is not a positive limitation in any patentable sense. The Board disagreed and reversed the examiner. Citing *In re Venezia, supra.*, the Board said that "the scope of the claims can be ascertained with a reasonable degree of precision and particularity."

Accordingly, the above-discussed claim construction technique of the Examiner was improper and his conclusions thus were incorrect, Applicant respectfully contends. Hence, all of the claim terms in the bodies of all of the independent claims (including the terms "capable of," "being constructed," "being configurable," "being structured," etc.) are positive limitations which are to be accorded patentable weight. They further distinguish the claims over the prior art, especially including *La Mers*.

III. Proposed Modifications that Render Prior Art Reference Inoperable for Its Intended Purpose Are Improper

Referring to MPEP 2143.01 which cites and relies on *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984), a proposed modification is inappropriate for an obviousness inquiry when the modification renders the prior art reference inoperable for its intended purpose.

IV. 35 U.S.C. 112 Rejection Should Be Withdrawn

Claim 185 (and those depending therefrom) was (were) rejected under 35 U.S.C. 112, first paragraph, due to the "negative" phrase "but not in the labels." Since that phrase has been deleted hereabove, the rejection should be withdrawn.

V. Rejection Based on "Obvious Duplication of Parts" Is Improper

Claim 148 was rejected because the Examiner contended that the second line "would have been [an] obvious duplication of parts of the first line in *La Mers*." The Examiner provided no discussion, explanation or case law support for this rejection.

This rejection is improper, Applicants respectfully contend. The Examiner appears to be relying on *In re Harza*, 274 F.2d 669 (CCPA 1966). However, the Examiner does not compare the facts in *Harza* with those in the present claims and explain why, based on this comparison, the legal conclusion in the present claims should be the same as that in *Harza*. Instead, the Examiner presumably relies upon *Harza* as establishing a *per se* rule that a duplication of parts would have been obvious. As stated by the Federal Circuit in *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995), "reliance on *per se* rules of obviousness is legally incorrect and must cease."

VI. Negative Limitations Are Not Indefinite

As stated in MPEP 2173.05(i), "[t]he current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. "

VII. Discussion of Patentability of Independent Claims

All of the claims patentably define over *La Mers* based on the elements in their last paragraphs, as explained in Section II above.

Claim 134 has been amended to include dependent claim 135. In other words, it is simply pending dependent claim 135 rewritten in independent form. It is respectfully contended that to modify *La Mers* to add the "short uncut sections of the facestock sheet, " such as shown at 200 in FIG. 1 of this application and claimed in original claim 4, would render *La Mers* unsatisfactory for its intended purpose and thus such modification is improper. See Section III above. This is because during the high speed dispensing of *La Mers* the uncut portion may result in a tearing of one of the first and second carrier strip portions causing the carrier strip to engage only one of the two peel plates and thereby malfunction, resulting in the labels not dispensing.

Claim 148 includes the first and second weakened lines, as shown for example by lines 148 and 180 in FIG. 1 of this application. One would not want to modify *La Mers* to include two lines because the thin strip of facestock material therebetween

would tend to carry the labels causing the machine to malfunction. Additionally, the *La Mers* machine is incapable of handling this third "carrier portion" formed by this thin strip. Thus, such modification is improper as set forth in Section III above.

Claim 174 includes that the line defines a "fold line" as shown by lines 148 and 180 in FIGS. 4-6. *La Mers* does not show a fold line, but rather shows a split/separation line as shown in FIG. 3 at 16. Further, *La Mers* does not disclose the limitations of the penultimate paragraph of claim 174. Instead of the sheet as claimed in that paragraph, *La Mers* discloses a narrow long strip roll. See *La Mers* FIGS. 4 and 14, for example. To modify *La Mers* to replace the narrow strip rolls with wide sheets would render *La Mers* unsatisfactory for its intended purpose. See Section III above.

Claim 185 has been amended to include the limitations of dependent claim 194. In other words, claim 185 is simply dependent claim 194 rewritten in independent format. Claim 185 thus defines the line as being offset from the centerline of the labels. This is shown for example in FIG. 1 at 148 or 180 or FIG. 7 at 248. This ensures that the label portions are in the released condition with the label sheet construction in the second configuration. One would not want to modify *La Mers* to have the offset arrangement because the labels would then be offset from the plunger 70. (See, e.g., *La Mers*, Col. 5, lines 35-40.) Thus, pursuant to Section III above, one would not so modify *La Mers*.

Claim 198 says that the weakened line segment is through the facestock sheet and to the liner sheet, but not through it. This is shown in FIG. 2 at 136, discussed in paragraph [0018] and set forth in original claim 19. In contrast, the line of *La Mers* is through the liner sheet, as shown in FIGS. 1 and 19. One would not modify the line 196 of *La Mers* so that it did not pass through the liner sheet because the first and second carrier strip portions would then not be separated as shown in FIG. 24. See Section III above.

Claim 212 is patentable for reasons similar to claim 198 as set forth above.

Claim 233 includes a plurality of rows and columns of facestock sheet labels releasably adhered to the liner sheet. This is illustrated for example in FIGS. 1, 7 and 8 which show multiple rows and multiple columns of labels. In contrast, *La Mers* shows

only one column of labels. One would not want to modify *La Mers* to provide for a plurality of columns because it would then not work due to the shape of the peel plate 22. It would not work because the machine disclosed in *La Mers* (see U.S. Patent 4,303,461) would not then work. If one wanted to increase the capacity of this machine, one would use a rotary bellows as shown in U.S. Patent 6,408,916 (Anderson et al) at 22 in FIG. 1. See Section III above.

Claim 235 includes that the weakened line segment does not penetrate through the exposed back surface. It is patentable for reasons similar to claim 198 as discussed above.

Claim 237 is patentable for reasons similar to claim 233 as discussed above.

Claim 239 is patentable for reasons similar to claim 198 as discussed above.

Claim 241 includes that the liner sheet is free of weakening lines under the label and aligned with the straight line. This is disclosed, for example, in paragraphs [0016] and [0022] of the present application. In contrast, *La Mers* clearly discloses that the separation line is in the liner sheet and under the label.

Claim 243 is patentable for reasons similar to those of claim 241 as discussed above.

VIII. Request for SPE to Co-Sign the Next Office Action

Applicants respectfully request that the supervisory patent examiner co-sign the next Office Action in this application, unless the Office Action is a Notice of Allowance, for the reasons set forth below.

Referring to MPEP 707.02, applications that have been pending for more than five years are to be carefully studied by the supervisory patent examiner and are to be considered "special" by the examiner. The present application was filed September 17, 2001 and thus has been pending nearly six years.

Referring again to MPEP 707.02, supervisory patent examiners are expected to personally check on the pendency of every application that is up for a third or subsequent action with a view to finally concluding its prosecution. The present

application has already received nine actions as itemized below wherein the Examiner has applied five different primary references in rejecting the claims.

1. Office Action dated 3/26/03 wherein claims were rejected over *Sato* (4,061,808).

2. Office Action dated 10/21/03 wherein claims were rejected over *Sato*.

3. Office Action dated 5/18/04 wherein rejections of claims over *Sato* were withdrawn and some of the claims were rejected over *La Mers* (4,454,180) and many of the other claims were allowed.

4. Office Action dated 10/1/04 wherein some of the claims were rejected over *La Mers* and other of the claims were allowed.

5. Office Action dated 2/23/05 wherein the prior rejections and allowances were withdrawn and the claims were rejected over *Grass* (4,188,251).

6. Office Action dated 9/23/05 wherein rejections over *Grass* were maintained.

7. Office Action dated 2/9/06 wherein rejections over *Grass* were maintained and claims were rejected over *Farrow* (6,149,518) and or *Atkinson* (6,479,118).

8. Office Action dated 10/31/06 wherein the *Atkinson* rejections were withdrawn and new/different *Farrow* rejections issued.

9. Office Action dated 6/13/07 wherein the *Farrow* rejections were withdrawn and new rejections issued over *La Mers* (the same *La Mers* patent which Applicant had overcome earlier in response to the Office Action dated 2/23/05).

Additionally, Applicants' below-signed Counsel and Applicants' technical representative, Dr. Ron Ugolick, traveled from Los Angeles to Virginia and conducted a personal interview on March 21, 2007 with the Examiner to discuss the present application. A sample of a commercial product of FIG. 1 was demonstrated by Dr. Ugolick, and the Examiner agreed that if certain amendments were made that the application would be allowable over the *Farrow* reference. These amendments were made in Applicants' next response, but instead of the application being allowed the Examiner rejected the claims over the *La Mers* reference, a reference the Examiner had previously applied and Applicants had overcome (see, e.g., claim 148).


Concluding Remarks

Accordingly, it is respectfully contended that all of the claims are in condition for allowance. Issuance of the Notice of Allowance at an early date is thus in order.

If there are any remaining issues, the Examiner is encouraged to telephone the below-signed counsel for Applicants at (310) 785-5384 to seek to resolve them.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 10-0440. Should such additional fees be associated with an extension of time, Applicants respectfully request that this paper be considered a petition therefor.

Respectfully submitted,



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